



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,326	11/07/2001	Richard Tiffin	RTIFFIN-1X	1491

7590 05/21/2003

MICHAEL A. GUTH
2-2905 EAST CLIFF DRIVE
SANTA CRUZ, CA 95062

EXAMINER

LEGESSE, NINI F

ART UNIT	PAPER NUMBER
----------	--------------

3711

DATE MAILED: 05/21/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/039,326	TIFFIN, RICHARD
	Examiner Nini F. Legesse	Art Unit 3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 November 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 1-7, 9 and 11-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-7, 9, and 11-19 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's amendment to claim 2 and cancellation of claims 8 and 10 is acknowledged in paper no. 6.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 5, 11, 12, 13, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Perrine (US Patent No. 5,803,826).

Perrine discloses a golf swing practice mat (10) comprising:

- A base element (14);
- Mark retaining surface means (12);
- Retaining means (column 7, lines 17-23);
- A rubber mat operably secured to said base element, wherein said rubber mat underlies said base element (column 6, lines 27-28. For example, Applicant has disclosed on his Fig. 1, the base (12) as a rubber mat (14). Therefore, the same can be concluded for the Perrine's device because the base element is indicated to be made of rubber as indicated above);
- Wherein said rubber mat is secured to said base element by adhesives (column 7, lines 20-23);

- Wherein said base element includes a substantially planar sheet of plastic (column 5, lines 1-4); and
- Wherein said mark retaining surface means comprise a wax containing surface (column 8, line 21).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perrine.

Perrine discloses the invention as recited above but fails to explicitly state wherein the rubber mat is secured to the base element by adhesive tape. However, Perrine teaches that the base element and the mat could be secured with a screw or could be thermally or adhesively bonded (column 7, lines 17-23). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an adhesive tape since it was known in the art that an adhesive tape could easily secure different elements together.

Claims 6, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perrine.

Perrine teaches that the top sheet (12) has a completely smooth and very low-friction surface that is made of a suitable type plastic (column 5, lines 1-4). However, he fails to teach that this planar sheet of plastic to be polycarbonate plastic and the retaining means to comprise fastening dowels. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the apparatus of Perrine with polycarbonate plastic or any other compatible plastic since Applicant has not shown the criticality for the claimed polycarbonate element. It appears that the practice mat of Perrine would accomplish similar purpose. And those skilled in the art may use a variety of plastics for the top sheet without departing from the spirit and scope of Perrine's invention. And with respect to the fastening dowels, Perrine teaches that the top sheet (12) and the Pad (14) are held together with a screw (column 7, lines 17-20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a screw as taught by Perrine or any other compatible fastening means including dowels that is well known in the art, since Applicant has not shown the criticality for the claimed fastening dowel. It appears that the screw of Perrine would accomplish similar purpose.

Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perrine in view of Manheck (US patent No. 3,754,764).
Perrine discloses that markings are provided on or under the top sheet for ball positions (column 7, lines 30-48 and lines 60-62). He also teaches that the top sheet (12) to have a visible substance like household spray-wax, or foamy soap solution to be applied to it to register the actual path of a golf club's head passing thought the hitting area when

the club head is in contact with the top sheet (column 8, lines 18-25). These elements appear to be no carbon elements. However Perrine fails to teach the presence of a sheet of no carbon paper. However, Manheck teaches about no carbon paper (column 2, lines 14-32). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a no carbon paper as taught by Manheck in the Perrine device in order to register the actual path of a golf club's head when a club head is in contact with a top sheet as a player swings his golf club. With the use of a no carbon paper the player could be able to save his swing marks of different days so that he could easily keep record of his progress with time.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perrine in view of Grossman (US patent No. 2,660,436).

Perrine discloses that markings are provided on or under the top sheet for ball positions (column 7, lines 30-48). He also teaches that the top sheet (12) to have a visible substance like household spray-wax, or foamy soap solution to be applied to it to register the actual path of a golf club's head passing thought the hitting area when the club head is in contact with the top sheet (column 8, lines 18-25). However Perrine fails to teach the presence of a sheet of carbon paper. However, Grossman teaches about carbon paper (41). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a carbon paper as taught by Grossman in the Perrine device in order to register the actual path of a golf club's head when a club head is in contact with a top sheet as a player swings his golf club. With the use of a

carbon paper the player could be able to save his swing marks of different days so that he could easily keep record of his progress with time.

Response to Arguments

Applicant's arguments filed 0318/03 have been fully considered but they are not persuasive.

Applicant argues that the top sheet 12 of Perrine (US Patent No. 5,803,826) is not a mark retaining surface means. However, column 8, lines 18-24 of the Perrine's patent teaches the top sheet (12) to have a visible substance like household spray-wax, or foamy soap solution to be applied to it to register the actual path of a golf club's head passing thought the hitting area when the club head is in contact with the top sheet.

From this it can be concluded that the top sheet (12) of Perrine can be considered as a mark-retaining surface.

Applicant argues that Perrine does not disclose, "a rubber mat operably secured to said base element, wherein said rubber mat underlies said base element" and a separate elements of the rubber mat and the base element. This limitation that applicant relies was not previously claimed. However, Perrine discloses a rubber mat operably secured to said base element, wherein said rubber mat underlies said base element (column 6, lines 27-28. For example, Applicant has disclosed on his Fig. 1, the base (12) as a rubber mat (14). Therefore, the same can be concluded for the Perrine's device because the base element is indicated to be made of rubber as indicated above.

Applicant's statement on page 6, lines 17-19 is not clear because there appears to be no Fig. 6 on the Perrine's Patent No. 5,803,826 and no item 117. And also the point that applicant is trying to make is not understood.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nini F. Legesse whose telephone number is (703) 605-1233. The examiner can normally be reached on Monday -Friday from 9:30 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell, can be reached on (703) 308-2126. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7768.

Art Unit: 3711

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Paul T. Sewell
Supervisory Patent Examiner
Group 3700